

REMARKS

Claims 1-74 are in the application. Claims 2-54 are amended to depend, directly or indirectly, from independent Claim 57 and to recite the "optical switch" thereof. Claim 57 is amended to avoid an objection to lack of antecedent basis. Claims 1, 55-56, and 62-73 are withdrawn. New Claim 74 is added, depending from Claim 57, directed to a plurality of optical switches that form a display device. Basis for new Claim 74 is FIG. 1 and the text associated therewith.

Applicants' undersigned representative appreciates that opportunity to have discussed the Restriction Requirement with Examiner Aulakh on June 25, 2006, at which time clarification of the nature of the Requirement was sought.

Claims 1-73 are subject to restriction under 35 USC 121 as follows:

Group I: Claims 1-34 and 36-56, drawn to a digital dye, classified in class 546, subclass 2.

Group II: Claims 1-13, 15-33, 35-56, drawn to a digital dye, classified in class 548, subclass 402.

Group III: Claims 1-13, 15-33, 35-56, drawn to a digital dye, classified in class 549, subclass 3.

Group IV: Claims 1-13, 15-33, 35-56, drawn to a digital dye, classified in class 548, subclass 541.

Group V: Claims 1-13, 15-33, 35-56, drawn to a digital dye, classified in class 549, subclass 206.

Group VI: Claims 1-13, 15-33, 35-56, drawn to a digital dye, classified in class 544, subclass 1+.

Group VII: Claims 57-61, drawn to an optical switch containing compounds of Group I, classified in Class 430.

Group VIII: Claims 57-61, drawn to an optical switch containing compounds of Group II, classified in Class 430.

Group IX: Claims 57-61, drawn to an optical switch containing compounds of Group III, classified in Class 430.

Group X: Claims 57-61, drawn to an optical switch containing compounds of Group IV, classified in Class 430.

Group XI: Claims 57-61, drawn to an optical switch containing compounds of Group V, classified in Class 430.

Group XII: Claims 57-61, drawn to an optical switch containing compounds of Group VI, classified in Class 430.

Group XIII: Claims 62-73, drawn to a display device containing compounds of Group I, classified in Class 364.

Group XIV: Claims 62-73, drawn to a display device containing compounds of Group II, classified in Class 364.

Group XV: Claims 62-73, drawn to a display device containing compounds of Group III, classified in Class 364.

Group XVI: Claims 62-73, drawn to a display device containing compounds of Group IV, classified in Class 364.

Group XVII: Claims 62-73, drawn to a display device containing compounds of Group V, classified in Class 364.

Group XVIII: Claims 62-73, drawn to a display device containing compounds of Group VI, classified in Class 364.

Applicants hereby elect to prosecute the Group VII set of claims (Claims 57-61, together with Claims 2-54 dependent thereon), with traverse. Applicants expressly reserve the right to file one or more continuation or divisional applications to any of the non-elected claims or similar claims, or with claims to any subject matter disclosed in the present application.

Applicants traverse the restriction requirement as follows:

35 USC 121 states that if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. By "independent" is meant that there is no disclosed relationship between the two or more inventions claimed (MPEP § 802.01). By "distinct" is meant that two or more inventions are (1) capable of separate manufacture, use or sale as claimed, and (2) patentable over each other (MPEP § 802.01).

Applicants submit that a proper restriction requirement would have been to require restriction between three groups of claims:

Group I: Claims 1-56, drawn to a digital dye;

Group II: Claims 57-61, drawn to an optical switch; and

Group III: Claims 62-73, drawn to a display device.

Election of species might then have been required as to the digital dyes.

However, to require **restriction** between, for example, Claims 57-61 based on different compounds that could be used as the digital dyes when Claim 57 is generic to all digital dyes disclosed in the application appears to strain credulity. Applicants would, for example, have to file five other divisional applications, all directed to Claims 57-61, each application apparently limited to a specific generic molecule (e.g., the specific generic molecules represented by Groups I-VI).

Applicants submit that independent Claim 57 is generic to optical switches that comprise a molecular system disposed between a pair of electrodes capable of generating an electric field, wherein the molecular system provides two different colors based on two different oxidation states of at least one digital dye in the molecular system, the digital dye having an optical change resulting from an electrochemical oxidation/reduction reaction. That is to say, Claim 57 is independent of the specific digital dye employed, so long as the digital dye meets the criteria of the claim. To say that each generic digital dye makes Claim 57 a separate invention, as apparently stated by the Examiner, has no basis in the law. Claim 57 is thus generic to all molecules disclosed, not just to the compounds disclosed in scheme 2-1 or scheme 2-2(A) (where one or none of K1, K2, and K5 represents N) or scheme 2-2(B) (where one or none of K1, K2, K3, and K4 represents N).

With regard to Applicants' election to prosecute Claims 57-61, together with Claims 2-54 as amended, the Examiner notes that the optical switch groups (Groups VII-XII) are all classified in the same class 430.

An Examiner may require restriction of claims presented in a single application for related, dependent inventions that are distinct if (1) each distinct invention has a separate classification in the Patent Office patent classification system, (2) each distinct invention has a separate status in the art, or (3) a different field of search is necessary for each distinct invention.

All groups of optical switch claims (Groups VII-XII) are within the same classification (class 430), all groups of optical switch claims are directed to the same generic invention (see Claim 57), and no different fields of search are required to search for the invention recited in Claim 57. Thus, no reasons exist for dividing among related

"inventions". Thus, the Examiner has failed to establish a *prima facie* case as to requiring restriction of Claims 57-61.

Accordingly, reconsideration of the restriction requirement, as between Claims 57-61 (Groups VII-XII) is respectfully requested.

Applicants submit that Claims 57-61 and 2-54, as amended, together with new Claim 74, should be examined at the same time.

The application is considered to be in condition for allowance. The Examiner is respectfully requested to take such action. If the Examiner has any questions, he is invited to contact the undersigned at the below-listed telephone number. HOWEVER, ALL WRITTEN COMMUNICATIONS SHOULD CONTINUE TO BE DIRECTED TO: IP ADMINISTRATION, LEGAL DEPARTMENT, M/S 35, HEWLETT-PACKARD COMPANY, P.O. BOX 272400, FORT COLLINS, CO 80527-2400.

Respectfully submitted,



David W. Collins
Reg. No. 26,857
Attorney for Applicants

July 13, 2006

512 E. Whitehouse Canyon Road
Suite 100
Green Valley, AZ 85614

Telephone calls may be made to:
(520) 399-3203